

REMARKS

Applicant has carefully reviewed the Office Action mailed March 29, 2004. By this Amendment, claims 5-6, 9, 11-14, 23-25 and 29-32 are canceled and claims 1, 4, 7-8, and 15-22 are amended. Claims 1, 4, 7-8, 15-22 and 26-28 are pending in this application. It is noted that Applicant has amended and cancelled the above-identified claims solely to advance prosecution of the instant application and to obtain allowance on allowable claims at the earliest possible date. Accordingly, no admission may be inferred from the amendments of claims herein. Applicant expressly reserves the right to pursue the originally filed claims in the future.

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,866,260 to Adams, Jr. et al. (hereinafter Adams) in view of U.S. Pat. No. 6,458,440 to Merritt (hereinafter Merritt) and U.S. Pat. No. 1,284,997 to Bigler (hereinafter Bigler).

Applicant's invention as recited in amended claim 1 is a method including the step of forming a tab by folding the substrate of a masking material so that a first portion of the substrate overlaps a second portion of the substrate. As noted by the examiner on page 3 of to the office action, Adams does not show the step of forming a tab by folding a substrate. Applicant respectfully submits that Merritt and Bigler also do not disclose a folded tab.

Rather than disclosing a folded tab, Merritt discusses a spacer element having an at least one adhesive carrying face with at least a portion of the adhesive carrying face being free of adhesive (column 1, lines 42-46). The examiner, however, "takes Official Notice of the equivalency of a folded tab and an unadhesive tab for their use in the covering art." In accordance with MPEP 2144.03, Applicant hereby traverses the Examiners taking of official notice.

Under 35 U.S.C. 103(a), "[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole

would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” In the instant case, the difficulty involved in removing the adhesive from the masking material of Adams to provide the adhesive free portion discussed by Merritt would dissuade the ordinarily skilled artisan combining the teachings of Adams and Merritt to yield a masking material having an adhesive free portion. For this reason, Applicant respectfully submits that claim 1 is now in condition for allowance.

Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Bigler and U.S. Pat. No. 5,330,232 to Smith (hereinafter Smith).

Applicant’s invention as recited in amended claim 4 is a method for forming a protective covering on a pane while leaving an unmasked apron surrounding the protective covering. Applicant’s claimed method includes the step of calculating a number of strips and an overlap dimension for forming the protective covering so that an unmasked apron surrounds the protective covering.

As noted by the examiner on page 3 of to the office action, Adams does not teach the step of calculating a number of strips and an overlap dimension for forming a protective covering sized so that an unmasked apron will surround the protective covering. Rather, Adams discusses a method in which strips of masking material are removed from marginal regions of a pane 18 to unmask a perimeter region of the pane 18 as shown in figure 4 of the Adams patent.

Under 35 U.S.C. 103(a), “[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” Because Adams provides one way of creating a pane with an unmasked perimeter region, the ordinarily skilled artisan reviewing this reference

would not have been motivated to seek additional ways to accomplish this. Accordingly, the ordinarily skilled artisan would not have been motivated to combine the teachings of Adams, Bigler and Smith to yield Applicant's claimed invention because Adams teaches that the need for a pane having an unmasked perimeter has already been satisfied. For this reason, Applicant respectfully submits that independent claim 4 is now in condition for allowance. Claims 7-8 and 15-22 depend from claim 4 and recite additional limitations, Applicant respectfully submits that these dependent claims are also in condition for allowance.

Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Bigler.

Applicant's claimed method as recited in claim 26 is a method comprising the steps of calculating a number of strips having a width  $W$  and an overlap dimension for forming a protective covering dimensioned so that an unmasked apron of a surface of a pane will surround the protective covering. A protective covering formed in this manner allows the unmasked apron to receive a sash while, at the same time, protecting a portion of the pane that is not covered by the sash.

As noted by the Examiner on page 10 of the present office action, Adams does not discuss the step of calculating a number of strips and an overlap dimension for forming a covering sized so that an unmasked apron of the surface will surround the covering. Accordingly, the Examiner relies on Bigler to provide this step.

Bigler describes a roof construction in which strips of varying width are obtained by "cutting the fabric throughout it's length." (Page 1, lines 65-66.) The strips of varying width are shown in figure 1 of Bigler. Figure 1 of Bigler also shows fabric strips covering the entire surface of a roof. The fact that Bigler shows a roof that is completely covered with strips and the fact that Bigler shows strips having varying widths demonstrates that this reference does not teach the step of

applying a plurality of strips having a width W to a surface for forming a protective covering with an unmasked apron surrounding the protective covering.

Under 35 U.S.C. 103(a), “[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The ordinarily skilled artisan would not have been motivated to combine the teachings of Adams and Bigler to yield Applicant’s claimed invention because Bigler shows strips having various unequal widths and because Bigler shows fabric strips covering an entire roof. For these reasons, Applicant respectfully submits that independent claim 26 is now in condition for allowance. Claims 27 and 28 depend from claim 26 and recite additional limitations, Applicant respectfully submits that these dependent claims are also in condition for allowance.

In light of the above discussion, Applicant respectfully submits that all of the claims are in condition for allowance and courteously requests prompt notice of the same. If a telephone conference would be of assistance, please contact the undersigned practitioner at 612/492-7000.

Respectfully submitted,



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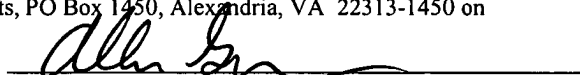
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